

## **REMARKS**

This Amendment and Response is submitted in response to the Office Action mailed 04 April 2004. The response is accompanied by a Petition for a one-month extension of time and the requisite fee to extend the due date for response until 05 August 2004. Withdrawal of the rejection and reconsideration with an eye toward allowance is respectfully requested.

### **Claim Status**

Claims 1-26 are pending after entry of the present amendment. Claims 1-16 stand rejected. Claims 1-16 are amended herein. Claims 2-6, and 11-12 were amended only to insert punctuation (a colon) and the amendments thereto are not related to patentability. Claims 7-10 were amended to change claim dependency. Claims 17-26 are added. A complete listing of all claims that are, or were in the application, along with an appropriate status identifier, is provided above in the section entitled "Amendments to the Claims". Markings are provided on claims amended in the present amendment.

Support for the above claim amendments can be found throughout the originally filed specification, drawings, and claims.

### **Claim Rejections – 35 U.S.C. §112**

The Examiner rejected claims 7-12 under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner suggested that there is insufficient antecedent basis for the "wherein the step of depositing" phrase in line 1. The claims depend from claim 5 which does not include a step of depositing.

Applicant has amended the claim dependency to correct this problem.

Accordingly, Applicant submits that claims 7-12 are free from rejection under 35 U.S.C. §112, second paragraph.

### **Claim Rejections – 35 U.S.C. §101**

Claims 1-16 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1, 13, and 15-16 are independent claims and have been amended to provide elements that provide for a “useful, concrete, and tangible result” as set forth in the test for statutory patent eligibility.

With reference to claim 1 as amended, the claim recites a method for cross marketing products between a first company and a second company over an interconnected plurality of point-of-sale terminals and a server. Applicant submits that this is useful, and additional elements in the claim present even more utility and usefulness. The claim also recites that an indication of the purchase of the first product of a first company by a particular consumer is stored in a database on the server, that the database is queried by the second company to determine if a discount should be offered, that revenues are calculated and recorded in a marketing fund in the database, and that at least a portion of this revenue is allocated to reimburse the second company for the discount. Applicant submits that these steps (and even a subset of these steps) provides the requisite concrete and tangible result. Applicants method or process claims also apply, involve, use, or advance the technological arts at least because they involve electronic sales or point-of sale terminals, servers, and/or other elements of the electronic, computer, network, and communication arts.

Accordingly, Applicant submits that Claim 1 and all claims dependent therefrom present statutory subject matter and that the 35 U.S.C. §101 rejection should be withdrawn.

With reference to independent claims 13, and 15-16 and the newly added claims, Applicant submits that they also satisfy the requirements for statutory subject matter. For example, the claim recites a useful method for cross marketing products between a first company and a second company over an interconnected plurality of electronic sales terminals and a server. The method includes among other elements, crediting an account of the consumer maintained at the server with the discount, and depositing a predetermined amount of money into an account maintained at the server for the benefit of the second company in at least partial compensation for accepting the discount. Applicant submits that Claim 13 recites elements that satisfy the requisite useful, concrete, and tangible result.

With reference to independent claims 15-16 as amended as well as the newly added claims, and without repeating the arguments outlined above, Applicant submits that each of these claims recites analogous structural and methodological elements that

satisfy the requirement to provide a useful, concrete, and tangible result. The claims dependent from each of these independent claims also recite statutory subject matter at least based on the independent claim from which they depend and further because of the additional structural and/or methodological elements they recite.

Accordingly, Applicant submits that all of the pending claims present statutory subject matter and that the 35 U.S.C. §101 rejection should be withdrawn.

#### **Claim Rejections – 35 U.S.C. §102**

Claims 1-16 were rejected under 35 U.S.C. §102(b) as being anticipated by “*As Children’s Taste in Premiums Sharpens, Kid Cereal Marketers Upscale Offers*” (hereinafter *Offers*).

Applicant has amended each of the independent claims to recite a method that is patentably distinct from the cited art.

As the Examiner is aware, for a reference to anticipate a claim, the reference must teach every element of the claim (see M.P.E.P §2131).

With reference to Claim 1 as amended, Applicant submits that *Offers* describes a very simplistic scheme and is silent as to and fails to disclose or suggest all the elements of the claimed method, as follows:

A method for cross marketing products between a first company and a second company over an interconnected plurality of point-of-sale terminals and a server, the method comprising the steps of:

identifying the purchase of the first product of a first company by a particular consumer at a first point-of-sale terminal and storing an indication of the purchase of the first product in a database on the server;

at the first company, conditioning the grant of a discount for a second product at a second company on the purchase of the first product at the first company; and

at the second company, offering for sale the second product if the particular consumer makes a purchase of the first product;

at the second company, querying the database to determine if the particular consumer has purchased the first product and standing ready to accept the discount on the second product;

calculating and recording an amount of cross-marketing revenue realized from the first purchase to a marketing fund account in the database; and

allocating at least a portion of the cross-marketing revenue in the fund to reimburse the second company for the discount.

In particular, *Offers* fails to disclose or suggest use of point-of-sale terminals or server, storing an indication of the purchase of the first product in a database on the server, querying the database to determine if the particular consumer has purchased the first product and standing ready to accept the discount on the second product, calculating and recording an amount of cross-marketing revenue realized from the first purchase to a marketing fund account in the database, and allocating at least a portion of the cross-marketing revenue in the fund to reimburse the second company for the discount. Each difference may separately provide a patentable basis for distinguishing over *Offers* so that any one of these differences will suffice to defeat a rejection under 35 U.S.C. §102(b).

Claims 2-12, dependent from Claim 1, are patentably distinct from *Offers* at least for the same reasons as Claim 1 and further because each adds additional limitations that further distinguish from the cited art. Accordingly, Applicants respectfully submit that *Offers* fails to disclose all limitations of Applicants' claim 1-12 or the claims dependent therefrom and the 35 U.S.C. §102(b) rejection of claim 1 as anticipated by *Offers* is improper and should be withdrawn.

Claims 13-26 though not identical to claims 1-12 recite generally analogous subject matter that is clearly distinguished from *Offers*. Rather than repeating each element of each of these claims, Applicant respectfully invites the examiner to review these claims as each has at least one element that is not disclosed or suggested by *Offers*.

Accordingly, Applicants respectfully submit that *Offers* fails to disclose all limitations of Applicants' claim 13-26 and the 35 U.S.C. §102(b) rejection of these claims as anticipated by *Offers* is improper and should be withdrawn.

//

//

//

//

//

## CONCLUSION

Prompt and favorable consideration of this Amendment and Response is respectfully requested. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is invited to call the undersigned at (650) 494-8700.

Respectfully submitted,

DORSEY & WHITNEY LLP

By   
R. Michael Ananian, Reg. No. 35,050  
Attorney for Applicants  
Filed under 37 C.F.R. §1.34(a)

Four Embarcadero Center - Suite 3400  
San Francisco, California 94111-4187  
Tel.: (650) 494-8700  
Fax: (650) 494-8771  
1076799